

REMARKS

In view of the following remarks, the Examiner is requested to withdraw the rejections and allow Claims 1, 3-8, 10, 11, 13, 14 and 16-20, the only claims pending and under examination in this application following entry of the above amendment.

Claim 17 is amended to provide the full name of the compound corresponding to "PABA".

As no new matter is presented, entry of this amendment is respectfully requested.

Claim Rejection under 35 U.S.C. §112

Claims 4 and 17 have been rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicant regards as the invention.

With respect to Claim 4, the Examiner states that "botanicals, antibiotics, and strobylurines are naturally occurring compounds." Claim 1 was previously amended to specify that the pesticide (of which botanicals, antibiotics and strobylurines are part of) is a synthetic pesticide. Accordingly, the invention is limited to those botanicals, antibiotics and strobylurines which can be synthesized. Synthesized in this form means man-made.

Claim 17 has been rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicant regards as the invention. Claim 17 is amended to spell out the abbreviation of PABA as para aminobenzoic acid.

Applicants respectfully request that this rejection of Claims 4 and 17 be withdrawn.

Claim Rejection under 35 U.S.C. §102(b) or §103(a)

Claims 1, 3-5, 7,8,11, 17-19 have been rejected under 35 U.S.C. § 102(b) or 35 U.S.C. §103(a) as allegedly being anticipated by, or in the alternative, obvious over Spengler (Pat. No. 6,669,879).

According to the M.P.E.P. § 2131, a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. Verdegaal Bros. v. Union Oil Co., 2 USPQ2d 1051 (Fed. Cir. 1987). Additionally, the identical invention must be shown in as complete detail as is contained in the claim. Richardson v. Suzuki Motor Co., 9 USPQ2d 1566 (Fed. Cir. 1990).

In addition, when the compound is not specifically named, but instead it is necessary to select portions of teachings within a reference and combine them. . . anticipation can only be found if the classes of substituents are sufficiently limited or well delineated. Ex parte A, 17 USPQ2d 1716 (Bd. Pat. App. & Inter. 1990). If one of ordinary skill in the art is able to "at once envisage" the specific compound within the generic chemical formula, the compound is anticipated. One of ordinary skill in the art must be able to draw the structural formula or write the name of each of the compounds included in the generic formula before any of the compounds can be "at once envisaged." One may look to the preferred embodiments to determine which compounds can be anticipated. In re Petering, 133 USPQ 275 (CCPA 1962).

An invention is not obvious under 35 U.S.C. §103, "where the prior art [gives] either no indication of which parameters [are] critical or no direction as to which of many possible choices is likely to be successful." Merck & Co., Inc. v. Biocraft Labs., Inc., 10 USPQ2D (BNA) 1843 (Fed. Cir. 1989) (quoting In re O'Farrell, 7 USPQ2D (BNA) 1673 (Fed. Cir. 1988)). "It is insufficient [when examining obviousness] to select from the prior art the separate components of the inventor's combination, using the blueprint supplied by the inventor." Fromson v. Advance Offset Plate, Inc. 225 USPQ 26 (Fed.

Cir. 1985). Some motivation to select the claimed species or subgenus must be taught by the prior art. In re Baird, 29 USPQ2D (BNA) 1550 (Fed. Cir. 1994).

The Office asserts that Spengler discloses a pesticide composition of chemical pesticides, crop treatment agents, vitamins, carbon-skeleton-sucrose, fats, cofactors, minerals and trace minerals, macro and micro nutrients and complexing agents. The Office further asserts that the instant language “comprising” is open, and thus there is no requirement for limitation as argued.

As a preliminary matter, Applicants respectfully posit that the Examiner’s interpretation of “comprising” is misplaced. MPEP §211.03 discusses *Genentech, Inc. v. Chiron Corp.*; “‘Comprising’ is a term of art used in claim language **which means that the named elements are essential**, but other elements may be added and still form a construct within the scope of the claim.” 112 F.3d 495, 501, 42 USPQ2d 1608, 1613 (Fed. Cir. 1997) (emphasis added). All limitations argued by the applicant that the compound must contain at a minimum the five named elements is in accord with the law.

Spengler does not disclose each and every element in the current invention. Specifically, Spengler does not disclose that the composition MUST comprise ALL of the following elements: (a) a synthetic pesticide; (b) an assimilable carbon-skeleton energy component; (c) a water soluble macronutrient; (d) a water soluble micronutrient; and (e) a vitamin/cofactor component. Spengler does not specify that the number and type of active ingredients MUST include at a minimum the five claimed elements recited in the present claims.

Spengler is drawn to a solid dosing that is capable of dispersing “all substances with a physiological action as long as they do not decompose under the processing conditions.” Spengler further defines this as “active pharmaceutical ingredients (for humans and animals), active ingredients for crop treatment, insecticides, active

ingredients for animal food and human food products, fragrances and perfume oils.” (See Col. 5, lines 60-66). Examples of possible fillers occupy fully two columns worth of information (See Col. 6-7). However, only three possible examples of crop treatments are provided: “vinclozolin, epoxiconazole, and quinmerac.”

There is accordingly no mention that various ingredients from the more carefully delineated classes of fillers may be combined. If the limitation were merely just the inclusion of more than one filler, the possible permutations of all the fillers disclosed by Spengler are huge. Including the various types of binder mentioned (which the Examiner cites as providing the carbon skeleton), leads to an even greater number. Thus, one of ordinary skill, confronted with the numerous possibilities for fillers presented by Spengler, would not be able to “at once envisage” a composition comprising the 5 elements in the instant claims.

Thus, Spengler neither discloses each and every element of the instant invention nor would one of ordinary skill be able to immediately envisage the instant product given the multitudinous filler espoused by Spengler.

In addition, there is no teaching or suggestion to combine at least the five claimed elements into a product. Spengler, by disclosing fillers ranging from pharmaceutical ingredients to human food products to fragrance oils (See Spengler, Col. 5 -6) does not provide any teaching or suggestion of the parameters that are critical to the instant application, claimed elements (a)-(e). The sole motivation or teaching provided in Spengler regarding filler selection is that the filler must be physiologically active and will not decompose under the processing conditions. (See Spengler, Col 5. line 60-63). There is no teaching or motivation in Spengler which shows that it is beneficial to structure the composition to include at a minimum those elements delineated in claimed elements (a) – (e). It is apparent that the Examiner is selecting separate components present in Spengler using the blueprint supplied by the instant application.

Therefore Spengler neither anticipates nor obviates the claims. As such, the rejection of Claims 1, 3-5, 7,8,11, 17-19 under 35 U.S.C. § 102(b) or alternatively under §103(a) may be withdrawn.

Claim Rejection under 35 U.S.C. §103(a)

Claims 1, 3-8, 10, 11, 13, 14 and 16-20 stand rejected under 35 U.S.C. § 103(a) as allegedly being obvious over Summers (3,514,516) in view of Beaty (5,634,959).

As stated in MPEP §2144.08: The fact that a claimed species is encompassed by a prior art genus is not sufficient by itself to establish a prima facie case of obviousness In re Baird, 29 USPQ2D (BNA) 1550 (Fed. Cir. 1994) (stating “[A] reference must be considered not only for what it expressly teaches, but also for what it fairly suggests.” In re Burckel, 201 U.S.P.Q. (BNA) 67, 70 (CCPA 1979).) Some motivation to select the claimed species or subgenus must be taught by the prior art. In re Baird, 29 USPQ2D (BNA) 1550 (Fed. Cir. 1994). Furthermore, an invention is not obvious under 35 U.S.C. §103, “where the prior art [gives] either no indication of which parameters [are] critical or no direction as to which of many possible choices is likely to be successful.” Merck & Co., Inc. v. Biocraft Labs., Inc., 10 USPQ2D (BNA) 1843 (Fed. Cir. 1989) (quoting In re O’Farrell, 7 USPQ2D (BNA) 1673 (Fed. Cir. 1988)). “It is insufficient [when examining obviousness] to select from the prior art the separate components of the inventor’s combination, using the blueprint supplied by the inventor.” Fromson v. Advance Offset Plate, Inc. 225 USPQ 26 (Fed. Cir. 1985). Some motivation to select the claimed species or subgenus must be taught by the prior art. In re Baird, 29 USPQ2D (BNA) 1550 (Fed. Cir. 1994).

In making this rejection, the Office asserts that Summers provides “the instant actives and compositions with fertilizers in spray, liquid or powder forms. The Office further asserts that Beaty discloses a fertilizer formulation which includes fish solubles and seaweed extracts, known vitamin and mineral sources, urea, ammonium phosphate, EDTA and trace minerals. .

The Office asserts that it would have been obvious to a person of ordinary skill in the art to use Summers as modified by Beaty to utilized pest control to include fertilizers.

The Applicant respectfully disagrees. None of the cited references teach or suggest a composition which MUST include at a minimum the elements of claim 1: (a) a synthetic pesticide; (b) an assimilable carbon-skeleton energy component; (c) a water soluble macronutrient; (d) a water soluble micronutrient; and (e) a vitamin/cofactor component, combined with a complexing agent. The Examiner asserts that the amounts of these items are result effective parameters, chosen to meet the needs of a specific crop or field. However, the requirement that the composition contain at minimum these 5 elements (a)-(e) and the specific identity of each of the components, is not taught by any combination result effective parameters.

The references only disclose the components piecemeal among their many other components, with no instruction of which pieces of among the many to chose. When numerous compounds are disclosed with no motivation to choose select compounds, there is not a prima facie case of obviousness. Following the Examiner's reasoning with regard to Summers in view of Beaty would lead to myriad other different combinations of pesticide and fertilizers. These combinations could consist of 4 components and still be within the reasoning of the Examiner. These combinations could not include micronutrients and still be within the reasoning of the Examiner. There is no teaching which shows that it is beneficial to structure the composition to include at a minimum those elements delineated in claimed elements (a) – (e).

Thus, the combined references of Summers in view of Beaty do no teach or suggest all of the claim limitations and therefore fail to render the instant claims obvious. Accordingly, this rejection may be withdrawn.

CONCLUSION

The Applicant submits that all of the claims are in condition for allowance, which action is requested. If the Examiner finds that a telephone conference would expedite the prosecution of this application, please telephone the undersigned at the number provided.

The Commissioner is hereby authorized to charge any underpayment of fees associated with this communication, including any necessary fees for extensions of time, or credit any overpayment to Deposit Account No. 50-0815, order number YAMA-009.

Respectfully submitted,
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Date: May 8, 2008

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